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Total Number of Pages in This Submission

Application Number 09/356,940

Filing Date 07/19/1999

First Named Inventor Joseph Grajewski

Art Unit 2621

Examiner Name B. Werner

Attorney Docket Number 438P470

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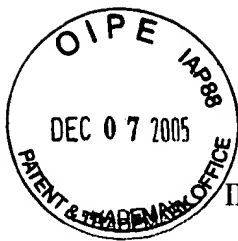
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Joseph Grajewski

Docket No. 438 P 470

Filed: July 19, 1999

Art Unit: 2621

Ser. No. 09/356,940

Examiner: B. Werner

For: Method of Authenticating Proper Access  
To Secured Site and Device for  
Implementation Thereof

Confirmation No. 8491

**REPLY BRIEF ON APPEAL**

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Sir:

The present Reply Brief on Appeal is filed in connection with the Notice of Appeal dated March 22, 2004, Appellant's Amended Brief on Appeal dated September 3, 2004, and the Examiner's Answer dated October 5, 2005.

### Status of claims

Claims 33-54, the only claims pending, stand under final rejection under 35 U.S.C. § 103(a) and are currently appealed. Claims 33-52 also stand under final rejection under 35 U.S.C. § 112, first paragraph and are currently appealed.

Grounds of Rejection to be Reviewed on Appeal

The claims, as represented by claim 45, were rejected as unpatentable under 35 U.S.C. § 103(a) over GB 2,274,184 to McIntosh (“*McIntosh*”) in view of U.S. Patent No. 5,944,824 to He (“*He*”) or, alternatively, *McIntosh* in view of U.S. Patent No. 5,732,138 to Noll (“*Noll*”). Claims 33-52 were rejected for failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

### Argument

Although the Examiner seemingly responded to the points raised by Appellant, the Examiner did not adequately address the deficiencies of the obviousness and indefiniteness rejections. In particular, the Examiner failed to explain how the simple notion that a random password is better than a non-random password sufficiently motivates the structural changes that are necessary to form the claimed invention. In addition, the Examiner failed to explain how the pending device claims that are completely supported by the specification fail to meet the written description requirement simply because the claimed device could be used in a manner not specifically recited in the specification. Accordingly, reversal of the rejections addressed in this Appeal is respectfully requested.

#### **I. THE EXAMINER HAS FAILED TO IDENTIFY A LEGALLY SUFFICIENT MOTIVATION OR SUGGESTION TO SUPPORT THE OBVIOUSNESS REJECTIONS**

The Examiner concedes that the primary reference, *McIntosh*, does not disclose the claim element calling for “password circuitry for generating a plurality of passwords, wherein each of said plurality of passwords is uniquely associated with a respective one of said plurality of indicia.” According to the Examiner, however, a secondary reference that discloses that a random password is better than a non-random password is sufficient to motivate the structural redesign of *McIntosh* to include circuitry for randomly generating a password and uniquely associating the password with indicia that represents a secure site.

The Examiner’s position that such a broad “teaching” about randomness can motivate the necessary structural changes is contrary to well-established precedent governing the analysis of obviousness. As explained by the Federal Circuit in *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000), the various elements of a claimed invention are often found in various references. As

a result, the burden is on the U.S. Patent Office to locate a motivation or suggestion of the desirability of making the *specific combination* claimed by Appellant. The Examiner has not fulfilled this requirement as the references relied on by the Examiner simply teach the fundamental principle that ‘randomness is better’ and therefore do not truly motivate the specific combination claimed by Appellant.

**A. *He* Merely Teaches that Random is Better, and Thus Does Not Motivate the Structural Changes to *McIntosh* that are Necessary to Form the Claimed Invention**

The basic principle that ‘randomness is better’ simply isn’t enough to motivate the specific combination claimed by Appellant. In order to form the claimed combination, *McIntosh* must be altered to include random number circuitry that is capable of associating the randomly generated passwords with each of the stored indicia. The Examiner did not identify a motivation for these changes to *McIntosh*, nor did the Examiner address Applicant’s argument that the simple principle that ‘randomness is better’ does not motivate the claimed combination under *In re Kotzab*. In particular, the Examiner never explained how the general notion that ‘randomness is better’ can sufficiently motivate or suggest the specific changes that must occur to *McIntosh* to form the claimed combination.

When applying the secondary reference, the Examiner took the teaching of *He* that network security may be improved by a network that generates random passwords entirely out of context. In particular, the Examiner divorced the simple principle that that ‘randomness is better’ from the teaching of *He* that implements that principle through the structural design of a computer network. The Examiner then applied the general principle that ‘randomness is better’ to the claimed invention without any regard for how *He* actually applied that basic concept. When considered in context, *He* teaches that network security may be improved by applying the

principle that ‘randomness is better’ through specific structure that generates random passwords for the network, rather than allowing a user to generate his or her own passwords. The reference therefore actually *teaches away* from the present invention because it discourages allowing a user to create and store passwords.

Even if *He* does not teach away from the present invention, the simple notion that randomness is better bears no relationship to the changes that the Examiner must make to the device of *McIntosh* to form the claimed invention. As explained by Appellant, *He* is directed toward improving network security by having a network server randomly generate the passwords that are later provided to users. *He* does not motivate having the *user* generate his or her own random passwords, and certainly does not motivate the inclusion of circuitry in a user’s hand-held device to generate random passwords and then store the passwords in combination with indicia of secure sites. This is the type of the motivation or suggestion that is required to form a proper obviousness rejection. As the Examiner failed to identify any such motivation, the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103.

In an effort to explain the disconnection between the Examiner’s interpretation of the teachings in *He* and *McIntosh*, Applicant schematically (and quite accurately) represented the basic teaching of the references. In response, the Examiner referred to Appellant’s explanation of the operation of *He* and *McIntosh* as “a fictitious structural and literal combination” and argued that that *He* was merely serving as a “teaching” reference relied on for “teaching the concept and benefits of a random password.” See Examiner’s Answer at 13. The Examiner argued that Appellant’s description of the prior art was fictitious because “the McIntosh system DOES NOT contemplate only storing passwords that have already been generated in advance.”

*McIntosh* is indeed strictly limited to a device that passively stores passwords that have already been generated, particularly since the device of *McIntosh* lacks any way to generate its own passwords. Thus, the depiction of the reference was entirely correct.

The Examiner accurately stated that Appellant's depiction of the modified system of *McIntosh* "is not at all the modification proposed" in the Examiner's rejection. See Examiner's Answer at 16. This difference is intentional, however, as Appellant depicted the structural changes to *McIntosh* that are actually motivated by the prior art in order to highlight the fact that a proper combination of the cited references would not actually form the claimed invention. See Brief on Appeal at 9 ("**Properly Modified McIntosh** According to *He*") (emphasis added). As the combination that is properly modified by the cited references is not the claimed combination, the obviousness rejection is improper.

To further highlight that the combination proposed by the Examiner is untenable, Appellant explained that the Examiner's proposed modification would impermissibly change the principle operation of *McIntosh*. In response, the Examiner argued that the proposed change is an addition to the device, rather than a change, and allow a user to select whether to store a non-random password or generate a random password. The Examiner failed to propose any motivation for this new "dual-mode" device which, in any event, still changes the principle operation of *McIntosh* from a device that stores previously existing passwords into a device that is capable of generating its own passwords.

As explained by Appellant, user generation of passwords would wreak havoc with the systems that are disclosed in *McIntosh*, *He* and *Noll*. In order to avoid this dilemma, the Examiner argued that the proposed combination could be used when a user opened a new account that allowed for the user to select a password of the user's choosing. This information



does not come from the prior art, and is apparently based on the Examiner's own experience or Appellant disclosure. As neither of these sources are proper bases for an obviousness rejection, the rejection under 35 U.S.C. § 103 is improper.

**B. *Noll* Merely Teaches that Random is Better, and Thus Does Not Motivate the Structural Changes to *McIntosh* that are Necessary to Form the Claimed Invention**

With regard to *Noll*, the Examiner has similarly failed to identify any sufficient suggestion or motivation to make the necessary changes to *McIntosh* to form the claimed invention. *Noll* simply teaches the general notion that random passwords are better than non-random passwords, and thus utterly fails to provide the necessary motivation to modify the structure of the portable device of *McIntosh* to include circuitry for generating random numbers for association with the indicia of secure sites, as presently claimed. As described with regard to *He*, the general principle that a random password is better than a non-random password is legally insufficient to render the claimed invention obvious because it fails to motivate every limitation of the claimed combination as required for a proper rejection under 35 U.S.C. § 103.

**II. THE EXAMINER HAS NOT EXPLAINED HOW DEVICE CLAIMS FAIL TO MEET THE WRITTEN DESCRIPTION REQUIREMENT SIMPLY BECAUSE THEY MAY ALSO READ ON A METHOD OF USE NOT DISCLOSED IN THE SPECIFICATION**

The Examiner does not dispute that the invention recited in claim 45 encompasses the method and device disclosed in the specification. In addition, the Examiner does not dispute that Appellant is not required to disclose every possible way of using the claimed invention in order to meet the written description requirement of 35 U.S.C. § 112, ¶ 1. Instead, the Examiner continued to assert that device claims fail to meet the written description requirement because they may be interpreted to cover a method of storing passwords that is not disclosed in the specification.

As an initial matter, the Examiner's interpretation of the claim language is entirely erroneous. The claims specifically recite that the circuitry associates "*each*" password with "*one*" of the indicia. It is unfathomable how this clear and precise claim language can be interpreted to call for a wholesale association of multiple passwords with multiple indicia, as erroneously interpreted by the Examiner. Moreover, the Examiner has constructed the claims without any reference to the specification, which would remove any ambiguity as to the meaning of the claimed invention—to the extent there ever was any ambiguity. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996) (holding that claims "must be read in view of the specification, of which they are a part"). As a concession to the Examiner's interpretation of the claims, Appellant added the additional language that "each of said plurality of passwords is uniquely associated with a respective one of said plurality of indicia *in sequence*." (emphasis added). Nevertheless, the Examiner continued to misinterpret the plain meaning of the claimed invention.

Regardless of the appropriateness of the Examiner's claim construction, the Examiner admitted that Appellant is not obligated to disclose every possible way in which a claimed device may be used. Examiner's Answer at 19; *see also Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) ("[a] claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim"). At the same time, however, the Examiner objected that the "claims currently cover a mode of operation that is not supported by the original disclosure." Examiner's Answer at 20. Since the Examiner does not dispute that the rejected claims also cover the method of using the device that is fully disclosed in the specification, the device claims are in

fact supported by the written description and the rejection under 35 U.S.C. § 112, ¶ 1 is improper.

### CONCLUSION

In conclusion, the Examiner failed to sufficiently explain the propriety of the 35 U.S.C. §§ 103 and 112, ¶ 1 rejections, or to rebut the compelling arguments presented by Appellant. In either case, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) or a *prima facie* case that the claims fail to meet the written description requirement of 35 U.S.C. § 112, ¶ 1. Accordingly, reversal of the rejections in this Appeal is respectfully requested.

Respectfully submitted,

Dated: December 5, 2005

By: 

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